

REMARKS

Claims 1-35 and 39-41 remain pending in the application, wherein claims 1, 3-5, 13, 18, 26, and 39 have been amended. No claims were added or cancelled.

The Office Action rejects claims 3-5 13, 14, 27, and 28 under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons set forth at page 2 of the Office Action. In response, Applicants have amended claims 3-5, 13 and 27 in order to address the indefiniteness rejections. Accordingly, Applicants respectfully request reconsideration and withdrawal of the indefiniteness rejections.

The Office Action rejects the claims in various ways utilizing U.S. Patent No. 6,838,403 to Tsai et al. and U.S. Published Application No. 2002/0098341 A1 to Schiffer et al. as the sole primary references. Because Tsai et al. and Schiffer et al. were both published subsequent to the filing date of the above-identified application, they are only citable under 35 U.S.C. § 102(e) and only if filed prior to the invention date of the subject matter defined by the claims in the above-identified patent application. Tsai et al. has a filing date of December 28, 2000. Schiffer et al. has an earliest effective filing date of December 7, 2000. As will be shown below, the invention described in leased claims 1-13 and 15-35 was invented prior to filing dates of Tsai et al. and Schiffer et al.

Filed concurrently herewith is the Declaration of Simon K. Hodson under 35 C.F.R. § 1.131 and exhibits A through G thereto. According to the Hodson Declaration, the concept of biodegradable food wraps comprising of one or more biodegradable polymers and an inorganic particulate filler was conceived as early as July 2, 2000. Hodson Decl., ¶ 6; Exh. A. A patent application was filed soon thereafter on August 23, 2000 as U.S. Application Serial No. 09/648,471. Hodson Decl., ¶ 7. This application issued as U.S. Patent No. 6,573,340 ("340 patent") on June 3, 2003. *Id.* at ¶ 8. The '340 patent discloses blends of biodegradable polymers and fillers, as well as biodegradable sheets and films, suitable for use in making food wraps that are similar or identical to blends and wraps disclosed and claimed in the above-identified application. As further evidence of this, Applicants refer to the obviousness-type double patent rejection set forth at page 9 of the Office Action. This rejection is evidence that the Examiner considers the claimed invention to be so closely related to the claims of the '340 patent as to not be patentably distinct.

After July 2, 2000, the inventors worked diligently to prepare and test various biodegradable polymer and filler blends on an ongoing basis to determine which worked best as a food wrap for their intended purpose. *Id.* at ¶ 11. Indeed, the '340 patent itself includes several working examples evidencing an actual reduction to practice of compositions and filled biodegradable polymer films used to manufacture food wraps. Moreover, the '471 application filed August 23, 2000 constitutes a constructive reduction to practice of whatever else was disclosed therein in addition to the blends that were actually made (*i.e.*, actually reduced to practice).

Attached to the Hodson Declaration as Exhibits C through G are documents that further evidence diligence in reducing to practice and testing a variety of biodegradable polymer and filler blends used to make films suitable as food wraps. An e-mail dated February 25, 2001 refers to "paper-like tissue, 30 micron", which refers to polymer films that were made before that date that included particulate fillers and that were stretched during processing (*i.e.*, "blowing") and/or that had filler particles that protruded from the surface of the film in order to create a roughened and/or porous surface that gave the film the look and feel of paper-like tissue. Hodson Decl., ¶ 12; Exh. C. An e-mail dated September 25, 2001 referred to the breathability of the paper-like wraps, indicating a level of porosity existed in such wraps, which is further evidence that the films were stretched to create the cavitation.

The subject matter of claim 1 is disclosed in all respects in the '340 patent, except for explicitly teaching that the sheet or film was stretched during processing so as to result in cavitation comprising tiny cavities in the vicinity of the filler particles. This property was present, according to the Hodson Declaration, in the "paper-like tissue" referred to in the February 25, 2001 e-mail, which resulted from the formulation identified in the July 2, 2000 e-mail, as well as some of the compositions described in the examples of the '340 patent. In view of this, Applicants submit that the subject matter of claim 1 was conceived and reduced to practice prior to the filing dates of Tsai et al. and Schiffer et al. The subject matter of claims 2-13 is also set forth in the '340 patent and/or described or alluded to in the e-mails attached to the Hodson Declaration. The same is true for the subject matter of claims 15-35. In view of the foregoing, at least the subject matter of claims 1-13 and 15-35 was invented prior to the filing dates of Tsai et al. and Schiffer et al. Hodson Decl., ¶ 18.

Without admitting that the subject matter of claims 14 and 39-41 was not also invented prior to the filing dates of Tsai et al. and Schiffer et al., Applicants submit that the subject matter of claims 14 and 39-41 is neither taught or suggested in any of the applied references. None of Tsai et al. or Schiffer et al. disclose compositions that include starch of any kind, let alone "thermoplastic starch that is free of plasticizers" as recited in claim 14 or "starch that is free of plasticizers" as recited in claim 39. U.S. Patent No. 6,096,809 to Lorcks et al. discloses biodegradable blends that include thermoplastic starch "obtained by processing native starch in the melt, by means of a plasticizing or swelling agent" that "as a rule" is included in an "amount of between 10 and about 40%" by weight of the mixture. Col. 1, l. 62, through col. 2, l. 4 (emphasis added). "Suitable swelling or plasticizing agents are, inter alia, for example, glycerol or sorbitol." Col. 2, ll. 4-6 (emphasis added). Applicants also refer to col. 7-11, Tables 1-4, each of which states that "TPS = thermoplastic starch = starch + sorbitol + glycerol < 0.1% H₂O" and "anhydrous TPS consists of starch, sorbitol and glycerol". In view of the foregoing, it is clear that Lorcks et al. neither teaches nor suggests "thermoplastic starch that is free of plasticizers" or "starch that is free of plasticizers" as recited in claims 14 and 39, respectively. In view of this, Applicants submit that claims 14 and 39-41 are patentable over the combined teachings of Tsai et al., Schiffer et al., and Lorcks et al.

Finally, claims 1-35 and 39-41 were rejected under the judicially created doctrine of obviousness-type double patenting relative to the claims of U.S. Patent No. 6,572,340 and U.S. application Serial Nos. 10/087,256 and 11/103,999. In response, Applicants are filing concurrently herewith a Terminal Disclaimer, thereby rendering the foregoing rejections moot.

In conclusion, Applicants believe the claims as now presented are allowable over the art of record. In the event there remains any other impediment to the prompt allowance of this application, the Examiner is requested to initiate a telephonic interview with the undersigned attorney.

Dated this 11th day of October 2005.

Respectfully submitted,



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